



UNITED STATES DEPARTMENT OF COMMERCE
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07/411574

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/411,576 09/22/89 MAGLICA

A 188167

EXAMINER

TUNG, H

29M1/1205

ART UNIT

PAPER NUMBER

30

2901

DATE MAILED:

12/05/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 8/27/93 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474..
6. 2 photocopies
7. photocopy of status letter 9/18/95

Part II SUMMARY OF ACTION

1. Claims 10 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims is finally are rejected.

5. Claims drawing is are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on 8/27/93. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

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1. Applicant's response and drawings received 08/27/93, and the status letter received 09/18/95 are acknowledged.

2. The drawing submitted 08/27/95 is objected to for the following reasons:

a) The solid black shading on the edge where the threaded portion meets the cylindrical barrel of the flashlight in Figs. 1 and 2 and on the sides of the flashlight head in Fig. 1 must be removed and replaced with appropriate line shading. The solid black obscures rather than clarifies the nature of the claimed design. In addition, solid black describes black surface ornamentation, which would be considered new matter. Note A on the attached photocopy.

b) The circular contour shown described as a broken line in the new Fig. 4 must be completed to show that it is claimed subject matter. Broken lines indicate unclaimed subject matter. Note B.

c) Additional shading is required for the bulb and bottom wall in Fig. 3 to clearly show that they are solid surfaces, not apertures. Note C.

Correction is required. 35 U.S.C. § 112 paragraph 1, 37 C.F.R. § 1.152.

3. A copy showing the proposed corrections must be submitted for the Examiner's approval. Care should be exercised to avoid introduction of new matter. (35 U.S.C. 132; 37 CFR 1.118). Applicant is required to submit a proposed drawing correction in response to this Office action. However, actual correction of the formal drawings can be deferred until the application is allowed by the examiner.

4. The decision rendered on 06/23/95 by the Board of Patent Appeals and Interferences affirmed the rejections of the claim under 35 U.S.C. 103 and 35 U.S.C. 112,

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first paragraph. However, because the Board's reasons for supporting both rejections went beyond the examiner's position, the rejections under 35 U.S.C. 103 and 35 U.S.C. 112, first paragraph are considered new grounds of rejection under 37 CFR 1.196(b).

5. The claim is again and FINALLY REJECTED under 35 U.S.C. § 103 as being unpatentable over Maglica (4,658,336) in view of Huang (4,750,095). The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under 35 U.S.C. § 103 should be withdrawn.

6. Whether the applied references establish a prima facie case of obviousness under 35 U.S.C. 103 is not in dispute. Instead, applicant argues that the Maglica ('336) and Huang patents would not qualify as prior art against the instant application if the benefit of the filing date of applicant's utility application 06/648,032 was accorded to the instant application. However, it remains the examiner's position that, because the shape of the flashlight head as shown in the new drawing submitted 08/27/93 still does not show the relatively sharp juncture between the cylindrical and tapered portions of the flashlight head, the benefit of the filing date of the utility application cannot be granted.

7. The drawing submitted 08/27/93 shows the bottom wall, the correct proportion of the diameter of central aperture relative to outer diameter of end disc portion, the correct proportion of the diameter of the end disc portion is now substantially the same as the diameter of the threaded portion, the beveled or conical shaped intermediate portion has been removed, and the textured mesh shown on the new drawings are now more coarsely textured

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with larger interstices, similar to that of the utility drawings. However, because the flashlight head still does not show the sharp juncture on the flashlight head, the benefit of the filing date is denied and the rejection under 35 U.S.C 103 stands final. In fact, there is no change to the flashlight head from the proposed drawings submitted 01/07/92 to the proposed drawings submitted 08/27/93.

8. Again, the examiner has compared the transparencies and still is not convinced that the flashlight head shapes of the instant application and the utility application '032 are the same. Though the change to the contour line may appear to be small, it is significant because it changes the overall appearance of the claimed design. The flashlight of the instant application shows a rounded, curved head and the '032 flashlight shows a head with a distinct change in plane. Note that enlarging a drawing can distort actual proportions.

9. The declarations of Martin J. Siegel and Jack B. Miller have been considered but do not change what visually is shown in the figure views of the '032 utility application. As the Board found in the decision of 06/23/93, the juncture between the cylindrical and tapered portions is

nevertheless sharp enough when viewed from the normal size of the drawings to conclude that it was not inconsistent or a draftsman's error to add the parting line Bd 1 in the perspective view of Figure 1 of the drawings as originally filed in the '032 utility application. (See Board decision, p.17).

10. The declarations listed as Exhibits A and B, the trial testimony labeled Exhibit C and Exhibit D, the drawing of Exhibit E, and the declarations listed as Exhibits F, G, and H

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have been considered but do not overcome the denial of the benefit of the filing date to the '032 utility application.

11. The claim is again and FINALLY REJECTED under 112, first paragraph for new matter. The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under 112, first paragraph should be withdrawn.

12. The drawing submitted 08/27/93 shows the bottom wall, the correct proportion of the diameter of central aperture relative to outer diameter of end disc portion, the correct proportion of the diameter of the end disc portion is now substantially the same as the diameter of the threaded portion, the beveled or conical shaped intermediate portion has been removed, and the textured mesh shown on the new drawings are now more coarsely textured with larger interstices, similar to that of the utility drawings.

13. However, the drawing does not overcome the rejection of the claim under 35 U.S.C. 112, first paragraph for introducing new matter for the following reasons:

- a) The proportions of the threaded portion still has not been corrected to the proportions shown in the original disclosure. The threaded portion still appears almost as wide as the cylindrical body. The threaded portion in the original disclosure is significantly narrower than the cylindrical body. Note AA on the attached photocopies.
- b) The disks below the bulb, and the disk at the end of the threaded portion in the new Figs.1 and 2 are new matter. The original Figs.1 and 2 show a single disk below the bulb and no disk at the end of the threaded portion. Note BB.

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In an attempt to overcome this rejection, proposed drawing corrections must be submitted that remove the new matter.

14. Applicant's new drawing contained the additional new matter as described in paragraph 12(b). Accordingly, final action is appropriate. **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Tung, whose telephone number is (703)305-3105. The examiner can normally be reached on Tuesday-Friday from 7:30 to 5:00. The examiner can also be reached on alternate Mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hugo Word, can be reached on (703)305-3171. The FAX phone number for this group is (703)-308-2742. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose

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telephone number is (703)-305-3293.

mht
December 1, 1995



M. H. TUNG
EXAMINER
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